

REMARKS

Claims 22-73 are pending in the Application and all have been rejected in the final Office action mailed February 6, 2008. No claims are amended by this response. Claims 22, 28, 29, 36, 43, 47, 51 and 60 are independent claims. Claims 23-27, 30-35, 37-42, 44-46, 48-50, 52-59 and 61-73 depend, respectively, from independent claims 22, 29, 36, 43, 47, 51 and 60.

The Applicants respectfully request reconsideration of the pending claims 22-73, in light of the following remarks.

Rejections of Claims

Claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken (WO 91/08629) in view of Richter, et al. (US 6,104,706, hereinafter "Richter"). Claims 43 and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Harrison et al. (US 5,796,727, hereinafter "Harrison"). Claims 27, 35, 42, 51, and 54 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Weaver et al. (US 5,956,673, hereinafter "Weaver"). Claims 23, 24, 30, 31, 37, 38, 48, and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Perkins (US 5,159,592). Claims 44 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Harrison and Perkins. Claims 52 and 53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter, Weaver, and Perkins. Claims 55 and 56 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Cripps (US 5,838,730). Claims 60, 61, 62, and 68-73 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton et al. (US 6,108,704, hereinafter "Hutton") and Reimer et al. (US 4,704,696, hereinafter "Reimer"). Claims 63-65 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton and Lewen et al. (US 5,341,374, hereinafter "Lewen"). Claim 66 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton, Lewen, and

McKee et al. (US 5,477,531, hereinafter "McKee"). Claim 67 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton and Cripps.

In addition, the Office rejected claims 22, 27-29, 32, 35, 36, 39, 42, 47, 50, 51, and 54 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter. Claims 23, 24, 30, 31, 37, 38, 48, 49, 52, and 53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter and Perkins. Claims 23, 24, 30, 31, 37, 38, 48, 49, 52, and 53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter and Perkins. Claims 43 and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Harrison. Claims 44 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Harrison and Perkins. Claims 25, 33, 40, and 55-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter and Cripps. Claims 26, 34, and 41 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter and Honig et al. (US 5,481,533, hereinafter "Honig").

The Office also rejected claims 22, 28, 29, 36, and 47 under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Shachar et al. (US 5,764,736, hereinafter "Shachar"). Applicants respectfully traverse the rejections.

Applicants respectfully submit that the Office action has failed to establish a *prima facie* case of obviousness, in accordance with M.P.E.P. §2142. According to M.P.E.P. §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. §2142 further states that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In addition, the Federal Circuit has made clear that "rejections on obviousness cannot be

sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396.

I. Richter Is Not Valid Prior Art

As an initial matter, Applicants respectfully maintain that the Richter reference (US 6,104,706, hereinafter "Richter '706") is not valid prior art, for at least the reasons set forth at pages 13-15 of Applicants' Amendment filed December 17, 2008 (the "Response").

Applicants demonstrated in the Response that Richter '706" is not, in and of itself, valid prior art, and that the Office cites Richter based upon a claim of priority to the filing date of an abandoned application that is not available for examination by the Applicants. Applicants clearly stated that Applicants have not been provided with "...such information and references as may be useful in judging of the propriety of continuing the prosecution of his application ...", as required under 35 U.S.C. §132.

In response to Applicants' arguments, the instant Office action states, in part:

35 U.S.C. 132(a) does not disclose or suggest the examiner to [sic] provide a parent application of a CONTINUED child case, and "continuing the prosecution of his application" is not "continuation of prior art application".

While U.S.C. §132 does not explicitly state that the Examiner is to provide a parent application of a continued child case, it also does not explicitly state that the Examiner is to provide a copy of a published foreign patent application, or a copy of a scientific journal article, etc. Applicants respectfully request that the Examiner explain why an abandoned patent application that is cited as prior art is exempt from the requirement set forth by 35 U.S.C. §132 and 37 C.F.R. §104(a)(2) that the Office make available any other cited reference. In addition, Applicants do not understand the

intended significance or meaning of the underlined text above, and believe that the examiner is misinterpreting Applicants' statements. Applicants respectfully submit that 35 U.S.C. §132 is quite clear, as shown below:

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

Applicants understand that the underlined portion above is not directed at a "...continuation of [a] prior art application...", as suggested by the Examiner. It is, however, a statement that the Director shall provide the reasons for the rejection, objection, or requirement set forth in an Office action, and shall provide the applicant with "...information and references..." that will allow the applicant to determine whether to continue to prosecute the application in question. It is clear that "references" in this context refers to, among other things, informational materials used by the examiner as a basis for a claim rejection, objection, or requirement. The Examiner recognizes this in the following statement, at page 32 of the Office action:

Thus, 35 U.S.C. §132(a) clearly states that the director [sic] shall notify the applicant [] references so that it may be useful for "the applicant" in judging the propriety of continuing the prosecution of his (i.e. the applicant) application. Moreover, prior art is not being examined, but the instant application is, and consequently there is no need to judge the propriety of continuing the prosecution of prior art application. Thus it is clear that 35 U.S.C. §132(a) does not recite anything about continuation of prior art application.

(emphasis added)

Applicants are puzzled why the Examiner is responding to an argument not set forth by the Applicants (i.e., "...judg[ing] the propriety of continuing the prosecution of prior art application..."). Applicants have not suggested that Richter '706 be examined by the Office. Applicants have not requested that the Office "...judge the propriety of continuing the prosecution of prior art application." The Applicants simply maintain, however, that it is the obligation of the Office to provide the references used in lodging a rejection, which the Office has failed to do. According to 37 C.F.R. §1.104(a)(2):

The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

(emphasis added)

Applicants respectfully submit that the portion of 37 C.F.R. shown above does not state that the Applicant will be provided with information that simply identifies the reference. The Applicants cannot respond to the arguments of the Office with only information that identifies a reference. Instead, 37 C.F.R. §104(a)(2) states that the references "...will be given...." The Applicants respectfully maintain that the Office has not provided a copy of or access to the Richter '706 disclosure allegedly used by the Office in preparing the rejections of the instant Office action. According to 37 C.F.R. §1.104(a)(1), the Examiner "...is to make a thorough investigation of the available prior art...." The Applicants are confident that the Examiner has fulfilled that obligation. The reference upon which the Office relies for validity of the prior art has not been made available to the Applicants for inspection. Instead, the Office has provided information (i.e., a patent number) to a subsequent continuation of the patent application whose filing date is relied upon as the basis for its citing as a "prior art" reference, which is not in accord with 37 C.F.R. §104(a)(2), or 35 U.S.C. 132.

Appln. No. 10/701,865
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Amendment filed August 5, 2008

Applicants respectfully submit that the Examiner is misinterpreting the requirements of 35 U.S.C. 37 C.F.R. and the M.P.E.P., as being proof that the disclosure of Richter '706 is exactly the same as the abandoned parent application, whose filing date is the basis of the Examiner's claim that Richter '706 is prior art.

The instant Office action states, at pages 42-43:

(2) The effective filing date for this instant application is October 5, 1995. Richter patent U.S. Patent to Richter (US006104706A), hereinafter refers [sic] Richter Patent, is based on DOMESTIC **CONTINUATION** of non-provisional application 08/073,956, field [sic] on June 9, 1993. Thus, it is clear that Richter patent is a valid prior art. Since Richter patent is based on DOMESTIC **CONTINUATION** [sic] of non-provisional application 08/073,956, field [sic] on June 9, 1993, the entire disclosure of Richter patent is identical to non-provisional application 08/073,956, field [sic] on June 9, 1993."

(emphasis and capitalization in original)

Applicants respectfully disagree with this statement. While the filing date of Richter '706 may predate Applicants effective filing date, it is not necessarily true that "...the entire disclosure of Richter patent is identical to non-provisional application 08/073,956, field [sic] on June 9, 1993...", as asserted by the Office.

The Office continues by citing M.P.E.P. §201.07, which states, in part:

A continuation is a second application for the same invention claimed in a prior nonprovisional application and filed before the original prior application becomes abandoned or patented. The continuation application may be filed under 37 CFR 1.53(b) (or 1.53(d) if the application is a design application). The applicant in the continuation application must include at least one inventor named in the prior nonprovisional application. The disclosure presented in the continuation must be the same as that of the original application; i.e., the continuation should not include anything which would constitute new matter if inserted in the original application. The continuation application must claim the benefit of the prior nonprovisional application under 35

U.S.C. 120 or 365(c). >For more information on claiming the benefit of a prior nonprovisional application, see MPEP § 201.11.<

(emphasis added)

The Applicants respectfully submit that the underlined portion above, identified by the Office, is not a statement of fact. It is simply a requirement for a patent application to qualify as a “continuation application” under 35 U.S.C. §120. To demonstrate using an analogy, many states have laws that require a driver to come to a stop at a “Stop” sign or “red light.” That is the law. The fact of what actually happens at a “Stop” sign or “red light” is quite different, and may be observed in just a few minutes at any street corner. The observation of what actually happens shows that many drivers, in fact, do not stop for a “Stop” sign. The requirement that drivers stop at a “Stop” sign or “red light” does not make it fact that they do so. Similarly, the requirement that a continuation application not introduce new matter does not mean that the cited teachings of Richter '706 are also present in the parent, upon which the Office is relying in its claim that Richter '706 is valid prior art in the rejections of the instant Office action.

Therefore, Applicants respectfully maintain that Richter '706 is not valid prior art in the rejections of the instant Office action, for at least the reasons previous set forth, and those now presented. If the Office should chooses to maintain the rejections that rely on Richter, Applicants respectfully request that the Examiner specifically identify the relevant portions in any of 35 U.S.C., 37 C.F.R, and/or the M.P.E.P. that guarantee that the disclosure of any continuation application is “identical” (to use the word chosen by the Examiner) to the disclosure of the corresponding parent application, or provide an affidavit by the Examiner, as required by M.P.E.P. §2260(d)(2), attesting to personal knowledge that the Office verifies that the disclosure of each continuation application is identical to its respective parent application. Otherwise, Applicants respectfully request that the Examiner withdraw any rejections that rely on Richter '706.

II. The Proposed Combination Of Berken And Richter Does Not Render Claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 Unpatentable

Claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken (WO 91/08629) in view of Richter, et al. (US 6,104,706, hereinafter “Richter”).

With regard to claims 22, 28, 29, 36, and 47, Applicants respectfully submit that it appears that the Office has simply copied the portion of the prior Office action related to the rejection of claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 in view of Berken and Richter, verbatim. See Office action of July 9, 2007 at pages 2-4. Applicants previously responded to the arguments of the July 9, 2007 Office action at pages 13-25 of the response filed January 9, 2008, and will not repeat those arguments again here.

Initially, Applicants respectfully submit that the rejection of claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 fails for at least the reason that Richter is not valid prior art, as established above.

Further, Applicants maintain that the Office has failed to show where the proposed combination of Berken and Richter teaches or suggests, at least, Applicants' claimed feature "...wherein the digital voice data packets comprise destination information used for routing the digital voice data packets...", as recited by Applicants' claims 22, 28, and 29, "...wherein the digital voice data is packetized according to a packet protocol comprising destination information used for routing the digital voice data packetized according to the packet protocol through the communication network;...", as recited by Applicants' claim 36, "...wherein the digital voice packets comprise destination information used for routing the digital voice packets...", as recited by Applicant' claim 47, and "...wherein the digital voice packets comprise destination information used for routing the digital voice packets through the network, the processing circuit packetizing the digital voice data according to a packet protocol...:", as recited by Applicants' claim 51.

The Office responds to Applicants' arguments of January 9, 2007 with respect to the alleged teachings of Berken at pages 33-39 of the instant Office action.

Applicants respectfully submit that Berken clearly teaches that time on the shared RF communications path is divided into **frames comprising a number of time slots** in a group for node transmit and a group used for node receive. Berken further teaches that each group is divided into three subgroups of control time slots, voice time slots and data time slots. See Berken Figs. 2 and 3; at page 8, line 30 to page 9, line 9; at page 10, line 16 to page 11, line 6. In other words, the **frame** of Berken is simply a period of time on the shared RF communication path.

The Office states, at page 36:

In response to argument, on control time slot of Berken,

1) examiner is not equating control packet to voice packet as argued by the application. Examiner is equating a frame that contains a control time slot and voice packet time slot (see Berken FIG. 2-3) to applicant's [sic] voice packet that comprises control information for routing. Berken FIG. 2 clearly shows that multiple time slots 1-M within a frame, which also confirms examiner'[s] assertion stated above. Thus, applicant argument of "the voice time slot is not within a control time slot is irrelevant and simply an error.

(emphasis in original)

Therefore, by the above statement, Applicants understand the Office to be identifying the frame of Berken as teaching Applicants' "digital voice packets/digital voice data packets" recited by Applicants' claims 22, 28, 29, 36, 47, and 51. Applicants respectfully point out that Applicants' claims 22, 28, 29, 36, 47, and 51 do not recite "...voice packet that comprises control information for routing...", as stated by the Office. Applicants' claims recite "**destination** information".

The Office continues by stating, at page 37:

2) the claim recites, "digital voice packet ... **comprises** destination information used for routing". Note that the phrase "comprise" is an open phrase and it does not require "destination information used for routing" to be "within", "inside", or "**consisting**". In other word [sic], the phrase

"comprises" is not the same as "within", "inside", or "consisting". Thus, the applicant argument on Berken not disclosing "destination information used for routing" **within/inside/consisting** is also irrelevant since the claimed invention does not recite the argued limitation. Even if this claimed limitation is claimed, Berken still discloses the claimed invention as set forth above

(emphasis in original)

Applicants respectfully disagree with these assertions, and respectfully request that the Examiner read Applicants' response of July 9, 2007 more carefully, in that the word "consisting" does not appear anywhere in Applicants' response, as suggested by the Office.

In addition, the Office states, at page 39:

In response to argument on "packet" and "frame" terms, both "packet" and "frame" has [sic] identical functionality of packaging or framing digitized voice data into the form (i.e. packet or frame) for transmission. Since they both have identical functionalities, they both are the same. Moreover, the combined system of Berken and Richter still discloses the "digitized voice data packet" as set forth above.

(emphasis in original)

Applicants respectfully disagree, and respectfully request that the Office specifically identify the authority that is the source of the definition of the terms "packet" and "frame" used by the Examiner in the rejection of Applicants' claims. Applicants respectfully disagree with the statement that the terms "packet" and "frame" have identical functionalities, as asserted by the Office, for at least the reasons set forth below.

Applicants respectfully submit that the Office has misinterpreted the language of Applicants' claims, and the teachings of the Berken reference.

Applicants respectfully submit that the term "packet" may reasonably be defined as "...n. 1. A unit of information transmitted as a whole from one device to another on a

network." (underline added) See Microsoft Computer Dictionary-Third Edition, Microsoft Corporation, 1997. Therefore, Applicants respectfully submit that a packet is sent from one device to another as a unit, that all parts of a packet are transmitted by one device to another, and that one of ordinary skill in the relevant art would immediately recognize that information of a "packet" may be correctly be describe as being part of, contained in, within, or inside the "packet". If a "packet" comprises a particular piece of information, that piece of information is part of the unit of information transmitted as a whole from one device or another for it to be "part of" the "packet". If it is not part of the unit of information labeled as a "packet", then it is not part of that "packet". If the Office believes this to be in error, Applicants respectfully request that the Office clearly and specifically identify the error in the above, with citation to authority.

Applicants respectfully submit that the term "frame" as it is used by Berken, and the term "packet" as defined above and used in Applicants' claims do not have identical functionalities, and are not "...both the same...", as asserted by the Office. The "frame" of Berken and the "packet" recited in Applicants' claims are not equivalent or interchangeable. A "packet", as illustrated by the definition cited above, is "...[a] unit of information transmitted as a whole from one device to another...." A "frame", as used by Berken, is a period of time, which Berken clearly explains is broken into a number of time slots which are allocated for use by different devices in the system of Berken until they are no longer needed, and are then de-allocated. See Berken at page 9, lines 10-27. The "control time slot" of Berken is used by "user modules" and "interface units" of Berken to request, among other things, the allocation and de-allocation of bandwidth on the shared communication path in terms of receive time slots and transmit time slots. See Berken at page 10, line 13 to page 11, line 6. Berken clearly teaches that the various "time slots" of a "frame", which the Office mistakenly identified as being equivalent to the "packet" of Applicants' claims, may be used by different entities of Berken, and that the various time slots of Berken are not part of "...[a] unit of information transmitted as a whole from one device to another on a network", in accordance with an the definition of "packet" of an industry authority. Therefore, the

assertion by the Office that the “frame” of Berken teaches Applicants’ “voice packet” is clearly erroneous.

Applicants’ Applicants respectfully submit that with regard to the use of the term “comprises/comprising”, a packet is not the same as, for example, a car, that may be described as comprising elements that may have various physical arrangements in three dimensions, including those outside of, for example, a body element, but that would still be recognized as “part of” a car. While it may be true that the terms “within” or “inside” cannot correctly be applied to the relationship of the “headlight” of a car being “inside” the car, the definition of “packet” as cited above makes it clear that a “packet” can properly be describing as “containing” the “information items” that are part of the “packet”.

The Office asserts, at page 36:

Applicant [sic] broadly claimed invention of “digital voice packets ... **comprises** destination information used for routing” is disclosed [by] Berken in two alternate scenarios:

In first scenario, a digital voice frame that comprises a digital voice time slot and a control time slot (see FIG. 2), and the control time slot comprise routing/transmitting/sending information such as address, control information and signaling information of the digital voice data so that the digital voice packet is distinguished and recover [sic] at the receiving side, which is the fundamental concept of the wireless communication. Otherwise, it is impossible to recover the wireless” [sic] digital voice data, or

In second scenario, a voice time slot/packet that comprises a digital voice packet data/information and packet preamble/packet header (FIG. 4), and the packet header/preamble comprise routing/transmitting/sending information such as address, control information and signaling information of the digital voice packet data/information so that the digital voice packet is distinguished and recover [sic] at the receiving side.

As previously shown above, the “first scenario” is not supported by the teachings of Berken, because the “digital voice time slot” and “control time slot” are not part of “[a] unit of information transmitted as a whole from one device to another”, in accordance with a reasonable definition of the term “packet”. Applicants respectfully submit that

Applicants' claims recite a "digital voice packet" or "digital voice data packet", not a "frame", and that Applicants have shown that a "packet", as recited by Applicants' claims, and a "frame" as taught by Berken, are not interchangeable or equivalent. While the control channel of Berken may be used to request allocation and de-allocation of bandwidth (in units of time slots on the shared communication path), it is not part of a "voice packet". Berken clearly states that "...[a]ll time slots are available for use by any node or module requesting bandwidth." See Berken at page 10, lines 20-21. Therefore, all information in the "frame" of Berken is not part of "[a] unit of information transmitted as a whole from one device to another...", in accordance with the term "packet".

The "second scenario" proposed by the Office suggests that "a voice time slot/packet" of Berken has a "packet header/preamble" that comprises "routing/transmitting/sending information such as address, control information and signaling information." Applicants respectfully submit that the Office has failed to show where Berken teaches that the "packet preamble" or "packet header" portions of a "time slot" comprise information used for routing the "voice time slot". In fact, Berken fails to teach anything about the contents of the "packet preamble" or "packet header" portions of a "voice time slot", let alone that information in the "packet header" or "packet preamble" of a "time slot" is used to route the "time slot" of Berken. Applicants respectfully request that the Office specifically identify where and how Berken teaches "address" information in the "packet preamble" or "packet header" portions of a "time slot". Indeed, Berken clearly states, repeatedly, that the "packet switch", "user module", and various "line" or "phone" interfaces of Berken send or receive information on the shared communication path "at the appropriate time." See Berken at pages 5-8. Therefore, Applicants respectfully submit that the Office has failed to show where Berken supports the "second scenario" set forth by the Office.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that Berken fails to teach or suggest, at least, Applicants' claimed feature "...wherein the digital voice data packets comprise destination information used for routing the digital voice data packets...", as recited by Applicants' claims 22, 28, and 29, "...wherein the digital voice data is packetized according to a packet protocol

comprising destination information used for routing the digital voice data packetized according to the packet protocol through the communication network;...”, as recited by Applicants’ claim 36, “...wherein the digital voice packets comprise destination information used for routing the digital voice packets...”, as recited by Applicant’ claim 47, and “...wherein the digital voice packets comprise destination information used for routing the digital voice packets through the network, the processing circuit packetizing the digital voice data according to a packet protocol...”, as recited by Applicants’ claim 51. Further, the Office fails to show where the Richter reference remedies the above-identified shortcomings of Berken. Also, Applicants have also established that the proposed combination of Berken and Richter fails to render claims 22, 25, 26, 28, 29, 32-34, 36, 39, 40, 41, 47, 50, and 57-59 unpatentable because Richter ‘706 is not valid prior art.

Therefore, Applicants respectfully submit that independent claims 22, 28, 29, 36, 47, and 51 are allowable over the proposed combination of Berken and Richter, for at least the reasons set forth above. Applicants respectfully submit that because claims 23-27, 30-35, 37-42, 44-46, 48-50 depend either directly or indirectly from allowable independent claims 22, 28, 29, 36, and 47, claims 23-27, 30-35, 37-42, 44-46, 48-50 are also allowable over Berken and Richter, as well, for at least the same reasons. Similarly, Applicants respectfully submit that claim 51, and its dependent claims, are not rendered unpatentable by the proposed combination of Berken, Richter, and Weaver, in that Weaver fails to remedy the shortcomings of Berken and Richter. Accordingly, Applicants respectfully request that the rejection of claims 22, 25, 26, 27, 28, 29, 32-35, 36, 39-42, 47, 50, 51, 54, and 57-59 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

III. The Proposed Combination Of Berken And Harrison Does Not Render Claims 43 And 46 Unpatentable

Claims 43 and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Harrison et al. (US 5,796,727, hereinafter “Harrison”). Applicants

have previously addressed the teachings of the proposed combination of Berken and Harrison, and will not repeat those arguments again here.

Applicants respectfully maintain that the proposed combination of Berken and Harrison does not teach or suggest Applicants' independent claim 43, which recites, in part, "...wherein the digital voice data packets comprise destination information used for routing the digital voice data packets through the network...", for at least the reasons set forth above with respect to claims 22, 28, 29, 36, and 47. In addition, Applicants respectfully submit that the Office has not shown where Harrison remedies the shortcomings of Berken described above. Therefore, Applicants respectfully submit that a *prima facie* case of obviousness has not been established, and that proposed combination of Berken and Harrison does not render Applicants' claim 43 unpatentable. Because claims 44-46 depend from allowable claim 43, Applicants respectfully submit that the proposed combination of Berken and Harrison also fails to render claims 44-46 unpatentable. Accordingly, Applicants respectfully request that the rejection of claims 43 and 46 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

IV. The Proposed Combinations Of Berken And Richter With Any Of Weaver, Perkins, And Cripps Do Not Render Claims 23, 24, 27, 30, 31, 35, 37, 38, 42, 48, 49, and 51-56 Unpatentable

Claims 27, 35, 42, 51, and 54 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Weaver et al. (US 5,956,673, hereinafter "Weaver"). Claims 23, 24, 30, 31, 37, 38, 48, and 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Perkins (US 5,159,592). Claims 55 and 56 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Richter and Cripps (US 5,838,730).

As an initial matter, Applicants have previously established that Richter '706 is not valid prior art. Therefore, for at least that reason, Applicants respectfully submit that the rejections of claims 23, 24, 27, 30, 31, 35, 37, 38, 42, 48, 49, and 51-56 under 35 U.S.C. §103(a) fail.

In addition, with regard to claim 51, Applicants respectfully submit that claim 51 recites, in part, "...wherein the digital voice packets comprise destination information used for routing the digital voice packets through the network, the processing circuit packetizing the digital voice data according to a packet protocol...." Applicants respectfully submit that the proposed combination of Berken, Richter, and Weaver fails to overcome the shortcomings of Berken and Richter, as set forth above. Further, Applicants respectfully submit that claims 23, 24, 27, 30, 31, 35, 37, 38, 42, 48, 49, and 51-56 are allowable over the proposed combinations of Berken and Richter with any of Weaver, Perkins, and Cripps, in that the Office has failed to show where any of Weaver, Perkins, and Cripps overcome the deficiencies of Berken and Richter. Accordingly, Applicants respectfully request that the rejection of claims 23, 24, 27, 30, 31, 35, 37, 38, 42, 48, 49, and 51-56 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

V. The Proposed Combinations Of Weaver And Any Of Richter, Harrison, Perkins, Cripps And Honig Do Not Render Claims 22-59 Unpatentable

The Office rejected claims 22, 27-29, 32, 35, 36, 39, 42, 47, 50, 51, and 54 under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter. Claims 23, 24, 30, 31, 37, 38, 48, 49, 52, and 53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter and Perkins. Claims 43 and 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Harrison. Claims 44 and 45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Harrison and Perkins. Claims 25, 33, 40, and 55-59 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter and Cripps. Claims 26, 34, and 41 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weaver in view of Richter and Honig et al. (US 5,481,533, hereinafter "Honig").

With respect to the rejections of claims 22-42 and 47-59 over the listed combinations that include Richter, Applicants respectfully submit that Applicants have shown that Richter is not a valid prior art reference, for at least the reasons set forth above. Therefore, for at least that reason, Applicants respectfully request that the

rejections of claims 22-42 and 47-59 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

With respect to the rejections of claims 43 and 46 under 35 U.S.C. §103(a) over the proposed combination of Weaver and Harrison, and of claims 44 and 45 over Weaver, Harrison and Perkins, Applicants respectfully submit that these rejections appear to be verbatim copies of the rejections of claims 43-46 set forth in the Office actions mailed May 2, 2006 at pages 10-12, in the Office action of October 17, 2006 at pages 22-24, in the Office action of July 9, 2007 at pages 24-25, and in the instant Office action at pages 24-26.

Applicants respectfully submit that the instant Office action repeats the earlier assertions of the Office that Weaver discloses "...wherein the digital voice data packets comprises [sic] information used for routing the digital voice data packets (see FIG. 3, 4, 9; voice packets comprise control/signaling information; see col. 3, line 20-40; see col. 5, line 34-46; see col. 6, line 52-65);...." See Office action at page 25. This same statement has been made in the Office actions of May 2, 2006 at pages 10-11, the Office action of October 17, 2006 at page 27, the Office action of July 9, 2007 at page 24, and the Office action of February 6, 2008 at page 25. In setting forth each of these rejections, the Office simply recites Applicants' limitation, and points the Applicants to portions of the Weaver reference, without any explanation of how and why a stream of information that is transported in the low-order bits of PCM samples carried by a circuit switched network to avoid tandem vocoding, would be recognized by one of ordinary skill in the art as teaching "...information used for routing the digital voice data packets...", as recited by Applicants claim 43. Applicants respectfully submit that the Office has failed to provide anything but conclusory statements, and has failed to set forth a "...clear articulation of the reason(s) why the claimed invention would have been obvious...", which is recognized in the M.P.E.P. at §2142 to be "...[t]he key to supporting any rejection under 35 U.S.C. 103." In addition, the Office has failed to show where Harrison remedies the shortcomings of Weaver set forth above, and during prior prosecution.

Therefore, for at least the reasons set forth above, Applicants respectfully submit that the Office has failed to meet the requirements of M.P.E.P. §2142, that the Office has not established a *prima facie* case of obviousness, and that the proposed combination of Weaver and Harrison does not render claim 43 unpatentable. Accordingly, Applicants respectfully submit that claim 43 is allowable over Weaver and Harrison, and that claims 44-46, which depend therefrom are also allowable, for at least the same reasons. Accordingly, Applicants respectfully request that the rejections of claims 43-46 under 35U.S.C. §103(a) be reconsidered and withdrawn.

VI. The Proposed Combinations Of Berken And Hutton Do Not Render Claims 60-73 Unpatentable

Claims 60, 61, 62, and 68-73 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton et al. (US 6,108,704, hereinafter "Hutton") and Reimer et al. (US 4,704,696, hereinafter "Reimer"). Applicants respectfully submit that claim 60, and its dependent claims 61-73 are allowable over the proposed combination of Berken, Hutton, and Reimer, for least the reasons set forth above, in that the Office has failed to show where either Hutton or Reimer remedy the deficiencies of Berken, set forth above. Because claims 61, 62, and 68-73 depend from claim 60, Applicants respectfully submit that claims 61, 62, and 68-73 are also allowable, for at least the same reasons. Applicants respectfully request, therefore, that the rejection of claims 60, 61, 62, and 68-73 under 35 U.S.C. §103(a), be reconsidered and withdrawn.

Claims 63-65 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton, and further in view of Lewen (US 5,341,374, hereinafter "Lewen") Claim 66 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton and Lewen, and further in view of McKee (US 5,477,531, hereinafter "McKee"). Claim 67 was rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Hutton, and further in view of Cripps. Applicants respectfully traverse the rejections. Applicants respectfully submit that claims 63-65, 66, and 67 depend either directly or indirectly from claim 60. Applicants believe that

claim 60 is allowable over the proposed combinations of Berken, Hutton, Lewen, McKee, and Cripps, in that Lewen, McKee and Cripps fail to overcome the deficiencies of Berken and Hutton set forth above. Because claims 63-65, 66, and 67 depend from allowable claim 60, Applicants respectfully submit that claims 63-65, 66, and 67 are allowable as well, for at least the same reasons.

In addition, Applicants respectfully submit that the admitted deficiencies that caused the Office to rely upon Reimer in the rejection of claim 60 necessarily exist in Berken and Hutton in regard to all of dependent claims 61-73. The rejections of claims 63-65, 66, and 67, however, do not recite combinations including Reimer. Therefore claims 63-65, 66, and 67 are allowable over the proposed combinations which are necessarily deficient. Therefore, Applicants respectfully request that the rejections of claims 63-65, 66, and 67 under 35 U.S.C. §103(a), be reconsidered and withdrawn.

VII. The Proposed Combination Of Berken And Shachar Does Not Render Claims 22, 28, 29, 36, and 47 Unpatentable

Claims 22, 28, 29, 36, and 47 were rejected under 35 U.S.C. §103(a) as being unpatentable over Berken in view of Shachar et al. (US 5,764,736, hereinafter "Shachar"). Applicants respectfully submit that the proposed combination of Berken and Shachar does not teach, suggest, or otherwise render obvious Applicants' claims 22, 28, 29, 36, and 47, in that the Office has failed to show where Shachar remedies the shortcoming of Berken, set forth above. Therefore, Applicants believe that claims 22, 28, 29, 36, and 47 are allowable over Berken and Shachar. Because claims 23-27, 30-35, 37-46, and 48-50 depend from allowable claims 22, 28, 29, 36, and 47, Applicants respectfully submit that those claims are allowable as well, for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of claims 22, 28, 29, 36, and 47 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Conclusion

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that all of pending claims 22-73 define patentable subject matter and are in condition for allowance.

Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any additional fees required by this communication, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

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